



Serial No.: 09/777,492
Docket No.: 257/103

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s) : Stephen B. Bove, et al.
Serial No. : 09/777,492
Filing Date : February 5, 2001
Title : System and Method for Anonymous Lead Generation and Management
Group/Art Unit : 3628
Examiner : Siegfried E. Chencinski
Confirmation No. : 8359
Docket No. : 257/103

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the rejection made in the Office Action of November 3, 2006 in the above-identified application.

- No amendments are being filed with this request.
- This request is being filed concurrently with a Notice of Appeal, applying previously paid appeal fees submitted with a previous Notice of Appeal filed on July 13, 2006. Applicant believes, in compliance with MPEP 1204.01, that no additional fees are due. If any such fees are required, the Director is authorized to charge Applicant's Deposit Account as indicated below.
- The review is requested for the reasons stated in the "Remarks" section on the attached sheets.

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on:

Date: February 5, 2007

Signature: Beth Rush

Printed Name: Beth Rush

The Director is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-4409.

REMARKS

In response to the Office Action dated November 3, 2006, and in conjunction with the Notice of Appeal submitted herewith, Applicant requests review of the rejection of claims 1-25 of the above-identified application for the following reasons:

1. The Examiner has failed to make a *prima facie* showing that independent claims 1, 9 and 16 are unpatentable under 35 U.S.C. § 103(a) over *Dahod et al.* (U.S. Patent No. 6,574,608, hereinafter "*Dahod*") in view of *Wilkins et al.* (U.S. Patent No. 6,868,389, hereinafter "*Wilkins*").

Independent claim 1 of the present application requires, among other things, "maintaining a prospect database identifying device-identifying information and corresponding prospect information comprising prospect-identifying information, anonymously submitted search criteria, and search information corresponding to said search criteria". Similarly, independent claim 9 of the present application requires "a database for storing prospects having anonymously submitted search criteria", and independent claim 16 of the present application requires the step of "generating a prospect having anonymously submitted search criteria".

In rejecting claims 1, 9, and 16 as obvious, the examiner states that "*Dahod* does not explicitly disclose a database which stores device identifying information", but that it would have been obvious to an ordinary practitioner in the art to retain device identifying information of both buyers and sellers (see page 3 of Office Action), and that *Wilkins* discloses the retention of buyer and seller information through cookies planted by Web site operators.

The invention claimed in the present application solves a problem that is not taught, disclosed, or suggested in the prior art. As stated in paragraph [14] of the present application, one of the objects of the present invention is to enable generation of business leads which are completely anonymous. That anonymity extends even to the provider of the lead generation system who is "unable to identify the consumer" (see paragraph [14] of present application). *Dahod*, on the other hand, requires registration of buyers and sellers and the submission of personal, identifying information which eventually is exchanged once a deal is

reached between the buyer and the seller. It makes no sense to combine *Dahod* and *Wilkins*, as suggested by the examiner, to include the cookies disclosed in *Wilkins*. Simply adding the *Wilkins* cookies to the *Dahod* system would not produce anonymous leads, as the users in *Dahod* are required to register with personal information. And replacing the user registration requirement in *Dahod* with the cookies of *Wilkins* is non-sensical, since the anonymity of such a system would prevent buyers and sellers from contacting each other, which is the purpose of the system of *Dahod*. Since the combination of *Dahod* and *Wilkins* suggested by the examiner would not even yield the invention claimed in claims 1, 9, and 16 of the present application, those claims are not obvious in view of the cited art, and the examiner's rejection should be withdrawn.

Additionally, in stating that it would have been obvious to one skilled in the art to modify *Dahod* to include a cookie as disclosed in *Wilkins*, which tracks and retains buyer and seller information, the examiner overlooks the requirement of anonymity in the claimed invention. In fact, the *Dahod* disclosure requiring registration by users and the *Wilkins* disclosure using user-identifying cookies (where "on line behavior can be tracked and often linked to a person's name, home address, and telephone number. . ." see *Wilkins*, Col. 2, lines 49-51) both teach away from the anonymous lead generation system claimed in the present invention.

In summary, *Dahod* and *Wilkins*, either alone or in combination, are antithetical to the system claimed in the present application. *Dahod* discloses collecting personal information and exchanging that information between registered buyers and sellers, *Wilkins* discloses cookies that link to a user's identity, and the system claimed in the present application, generating leads of users who remain anonymous. There is absolutely no suggestion in the art to combine *Dahod* and *Wilkins* as suggested by the examiner, and doing so would yield only a non-sensical system, not the anonymous lead generating system claimed in the present application. Thus, independent claims 1, 9 and 16 of the present application (and thus dependent claims 2-8,

10-15, and 17-20) are not obvious in view of *Dahod*, and the examiner's rejection should be withdrawn.

2. The Examiner has failed to make a *prima facie* showing that claims 21-23 are obvious under 35 U.S.C. § 103(a) over *Dahod* in view of U.S. Published Application No. 2002/0169626 to *Walker*, or that claims 24 -25 are obvious over *Dahod* in view of *Walker* in further view of U.S. Patent No. 6,662,199 to *Flight*.

Independent claim 21 of the present application requires, among other things, storing search criteria in association with search-requestor information, without a requirement of user registration. As discussed above, the buyer-driven system of *Dahod* teaches away from a non-registration system, and specifically requires users to register in order to receive proposals from the system (see *Dahod*, column 5, lines 7-21. Similar to *Dahod*, *Walker* requires that merchants register in the system with their contact information (see FIG. 9, and paragraph [0062] of *Walker*). Thus, like *Dahod*, *Walker* also teaches away from a non-registration system as claimed in claim 21 of the present application.

As stated in MPEP §2145, it is improper to combine or modify references where the references teach away from that combination or modification. Here, *Dahod* and *Walker* each teach away from allowing users to access the system without first registering. There is absolutely no disclosure, teaching, or suggestion in either *Dahod* or *Walker* to allow anonymous use of the system, as required in claim 21 of the present application. Nor would it even make sense to do so, since the systems of *Dahod* and *Walker* are intended to match an identifiable buyer to an identifiable seller. Thus, for at least this reason, the examiner's rejection of claim 21 is unsupported by the art, and should be withdrawn.

In addition, claim 21 of the present application requires storing search criteria in association with search-requester information. Neither *Dahod* nor *Walker*, nor their combination, make any teaching, suggestion, or disclosure of storing such search criteria. As stated in MPEP §2143.01, the mere fact that references can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the

modification. There is no suggestion of the desirability of storing search criteria in either *Dahod* or *Walker*, thus, the Examiner's proposed combination of *Dahod* and *Walker* also fails to suggest the storing of such criteria. For this additional reason, the Examiner's rejection of claim 21 should be withdrawn.

Claims 22-25 depend from claim 21. Since claim 21 is allowable for the reasons just discussed, claims 22-25 are thus also allowable.

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In view of the foregoing remarks, it is respectfully submitted that the claims of the present application are in condition for allowance and eventual issuance. Such action is respectfully requested.

Should this Review Board have any further questions or comments that need be addressed in order to obtain allowance, it is invited to contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

By: 
Mark C. Young, Reg. No. 48,670
STINSON MORRISON HECKER LLP
1201 Walnut Street, Suite 2900
Kansas City, MO 64106-2150
Telephone: (816) 842-8600
Facsimile: (816) 691-3495